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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 12

Application Number: 09/683,381
Filing Date: December 19, 2001
Appellant(s): CORDERY ET AL.

Robert A. Cordery et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 23, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

However, the amendment to claim 16 has not been entered because a particular amendment (i.e. just for claim 16) cannot partially be entered when the rest of the entire amendments couldn't come in.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: whether claim 16 is patentable under 35 U.S.C. § 112, second paragraph is not an issue in this instant appeal due to the above described reason in **(4)**.

(7) Grouping of Claims

Appellant's brief includes a statement that (I) claims 1-2 and 9; (II) claims 3-8, 10-12 and 16-17; (III) claims 13 and 15; and (IV) claims 14 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). However, the Group numbers (IV) and (V) should be changed to (III) and (IV), respectively. In addition, in Group IV, claim 14, not claim 8, should depend directly from claim 10.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

2003/0136203	YOON	07-2003
2003/0072469	ALDEN	04-2003

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (US 2003/0136203 A1) in view of Alden (US 2003/0072469 A1).

As for Claim 1, Yoon discloses a system comprising:

a plurality of detectors (114) each including a contaminant detection hazard detector (see Figs. 4-5) for a triggering a mail piece quarantine indication (see para. [0124]); and

a communication system between the detectors and a computer (137), the computer receiving scan detection data and determining a notification method and for communicating the notification to an operator (by sound, flashing screen, e-mail and other communication methods; see para. [0019]).

However, Yoon does not expressly disclose the system including:

an image scanner for scanning the face of a mail piece;

a scan detection system for providing sender and recipient information;

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

an image scanner for scanning the face of a mail piece (see Figs. 5-9);

a scan detection system for providing sender and recipient information (see Figs. 5-9, especially Figs. 8-9 for communicating the notification to at least one of the sender and the recipient; and the description thereof);

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient by the network (*Id.*).

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system further includes: an image scanner; a scan detection system; and a server connected to the plurality of hazard detectors, as taught by Alden, for the purpose of providing means for communicating the result of detection data to at least one of the sender and the recipient's computer via a network (see para. [0005]).

As for Claim 2, Yoon does not expressly disclose the system further including a secure Internet connection between each hazard detector system and the server.

Alden further teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the system comprises a secure Internet connection between a hazard detecting system and the server (see Figs. 7-8).

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system further includes the secure Internet connection between each hazard detector system and the server, as taught by Alden, for the purpose of sending an image or other information regarding the hazardous mail pieces to the intended recipient's computer via a network and minimizing concomitant potential for terrorist exposure (see para. [0005]).

As for Claim 9, Yoon discloses a system comprising:

a plurality of mailboxes (109) each including a plurality of detectors (114) each including a contaminant detection hazard detector (see Figs. 4-5) for a triggering a mail piece quarantine indication (see para. [0124]); and

a communication system between the detectors and a computer (137), the computer receiving scan detection data and determining a notification method and for communicating the notification to an operator (by sound, flashing screen, e-mail and other communication methods; see para. [0019]).

However, Yoon does not expressly disclose the system including:

an image scanner for scanning the face of a mail piece;

a scan detection system for providing sender and recipient information;

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

an image scanner for scanning the face of a mail piece (see Figs. 5-9);

a scan detection system for providing sender and recipient information (see Figs. 5-9, especially Figs. 8-9 for communicating the notification to at least one of the sender and the recipient; and the description thereof);

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient by the network (*Id.*).

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system further includes: an image scanner; a scan detection system; and a server connected to the plurality of hazard detectors, as taught by Alden, for the purpose of providing means for communicating the result of detection data to at least one of the sender and the recipient's computer via a network (see para. [0005]).

2. Claims 3-8, 10-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Alden.

As for Claim 3, Yoon discloses a method for communicating a quarantine condition to users comprising:

detecting the presence of a mail piece (see Fig. 8 for the system detecting the presence of the mail piece);

detecting source information from the mail piece (see paragraph [0039] on page 2);

testing the mail piece for hazards (see Figs. 8-10) to determine an initial mail piece quarantine condition (see para. [0124]);

alerting an operator upon detection of a hazard (by sound, flashing screen, e-mail and other communication methods; see para. [0019]); and

notifying at least one user of the mail piece quarantine.

However, Yoon does not specifically disclose the method including:

alerting a central server upon detection of a hazard and providing source information to the central server; and

determining a notification method.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

scanning the face of a mail piece (see Figs. 5-9);

providing sender and recipient information (see Figs. 5-9 and the description thereof); and

alerting a server, which is connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient (*Id.*).

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system alerts the central server upon detection of a hazard and providing source information to the central server; and determines a notification method, as taught by Alden, as taught by Alden, for the purpose of providing means for communicating the result of detection data to at least one of the sender and the recipient's computer via a network (see para. [0005]).

As for Claim 4, the modified method of Yoon further discloses the method, wherein the source detection includes detecting a destination address (see Fig. 9 of Alden, for example), as taught by Alden, for the purpose of sending the image of the mail piece to the intended recipient via a network.

As for Claim 5, the modified method of Yoon further discloses the method, wherein the source detection includes detecting a return address (see Fig. 9 of

Alden, for example), as taught by Alden, for the purpose of scanning the mail to find out whether the sender is known to the recipient or not (para. [0016]).

As for Claim 6, the modified method of Yoon further discloses the method, wherein the determination of a notification method comprises determining if a valid e-mail address is available for the user (both Yoon and Alden discloses a system and method for notifying the user (see Supra; Yoon - upon detection of a hazard by sound, flashing screen, e-mail and other communication methods; see para. [0019]; Alden – see Figs. 7-8, obviously, the communication between the local computer and the server must include e-mail).

As for Claim 7, the modified Yoon discloses the invention as recited above but does not expressly disclose the method further including the step from Claim 7.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a telephone as the notification means because Applicant has not disclosed that the above cited limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Yoon in view of Alden because Yoon also discloses the notification by sound, flashing screen, e-mail and other communication methods (; see para. [0019]) and the notification means would obviously include using the telephone.

Therefore, it would have been an obvious matter of design choice to further modify the modified system of Yoon to obtain the invention as specified in claim 7.

As for Claim 8, the modified method of Yoon further discloses the method, wherein the determination of a notification method comprises determining if the mail piece address is a valid postal address for the user, as taught by Alden (see Fig. 9 for example, the user can determine the validity of the postal address via GUI), for the purpose of scanning the mail piece and insulating the user from the potentially hazardous mail piece.

As for Claim 16, as far as it is definite, the modified method of Yoon further discloses the method, wherein the recipient information comprises a scan (see the GUI of the mail piece in Fig. 9 of Alden).

As for Claim 17, the modification method of Yoon further discloses the method including: detecting destination information from the mail piece (see Fig. 9 for example of Alden), as taught by Alden, for the purpose of sending the image of the mail piece to the intended recipient via a network.

As for Claim 10, Yoon discloses a method for communicating a quarantine condition to users comprising:

detecting the presence of a mail piece (see Fig. 8 for the system detecting the presence of the mail piece);

detecting sender information from the mail piece (see paragraph [0039] on page 2);

testing the mail piece for hazards (see Figs. 8-10) to determine an initial mail piece quarantine condition (see para. [0124]);

alerting an operator upon detection of a hazard (by sound, flashing screen, e-mail and other communication methods; see para. [0019]); and

notifying at least one user of the mail piece quarantine.

However, Yoon does not specifically disclose the method including:

alerting a central server upon detection of a hazard and providing source information to the central server; and

determining a notification method.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

scanning the face of a mail piece (see Figs. 5-9);

providing sender and recipient information (see Figs. 5-9 and the description thereof); and

alerting a server, which is connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for

communicating the notification to at least one of the sender and the recipient (*Id.*).

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system alerts the central server upon detection of a hazard and providing source information to the central server; and determines a notification method, as taught by Alden, as taught by Alden, for the purpose of providing means for communicating the result of detection data to at least one of the sender and the recipient's computer via a network (see para. [0005]).

As for Claim 11, the modified method of Yoon further discloses the method, wherein the source detection includes detecting a destination address (see Fig. 9 for example), as taught by Alden, for the purpose of sending the image of the mail piece to the intended recipient via a network.

As for Claim 12, the modified method of Yoon further discloses the method, wherein the source detection includes detecting a return address (see Fig. 9 for example), as taught by Alden, for the purpose of scanning the mail to find out whether the sender is known to the recipient or not (para. [0016]).

3. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Alden.

The modified Yoon discloses the invention as recited above but does not expressly disclose the method further including the steps from Claims 13 and 15.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

scanning the face of a mail piece (see Figs. 5-9); and providing GUI to the user to virtually view the any information on the mail piece (including the meter number if the number is present on the mail).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to detect a meter number for the sender information because Applicant has not disclosed that the above cited limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Yoon in view of Alden because the modified system of Yoon can notify the user of the detection of hazard by providing the intended recipient with the virtual view of mail pieces that may include the meter number such that the scanning service can exercise the intended recipient's elections whether to receive the mail piece or not.

Therefore, it would have been an obvious matter of design choice to further modify the modified system of Yoon to obtain the invention as specified in claims.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Alden.

The modified Yoon discloses the invention as recited above but does not expressly disclose the method further including the step:

storing a plurality of sender information records relating to a plurality of mail pieces placed in the at least one mailbox; and

if the initial mail piece quarantine condition is detected, notifying at least two users indicated by the plurality of sender information records.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to facilitate the existing database of the modified system of Yoon to store the sender information because Applicant has not disclosed that the above cited limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Yoon in view of Alden because the modified system can notify the user of the detection of hazard and further utilize the existing database to include the sender information.

Therefore, it would have been an obvious matter of design choice to further modify the modified system of Yoon to obtain the invention as specified in claim.

(11) Response to Argument

- IN RESPONSE TO Appellant's argument A, the Yoon and Alden are not properly combined under 35 U.S.C. section 103(a):

In response to appellant argument that the examiner does not provide a copy of the earlier reference (Yoon) to support an earlier filing date, the copy of the provisional application No. 60/344,635, filed on Oct. 26, 2001 is provided with this Answer.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yoon discloses a hazardous mail piece detecting system to determine an initial mail piece quarantine condition (see para. [0124]); alert an operator upon detection of a hazard (by sound, flashing screen, e-mail and other communication methods; see para. [0019]); and notify at least one user of the mail piece quarantine. Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process. The remote

scanning and detecting system of Alden would enhance the system of Yoon to further minimize the concomitant potential for terrorist exposures and provide means for communicating the result of detection and quarantine data to at least one of the sender and the recipient's computer via a network.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument that Alden does not even describe detecting source (sender) information from the mail piece, the examiner again invites the appellant's attention to the Fig. 9 of Alden, the GUI displays the scanned image of the mail piece and the sender information can be detected or just simply read from the GUI screen by the user to find out where the mail pieces has been sent from.

- IN RESPONSE TO Appellant's argument B, Claims 1-2 and 9 are not Unpatentable under 35 U.S.C. section 103(a):

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). When combined, the modified invention of Yoon would disclose the system that provides the user information for quarantined mail pieces because Yoon discloses the system to notify the user of quarantined mail piece (para. [0124]; the particle sample or the whole airtight box may be removed and sent into the lab for ...) and Alden suggests the system for providing the scanned image and data of the potentially hazardous material to the user via network, for the purpose of improving the detecting system of Yoon to be remotely accessed by users and notifying the user of the whole situation , as taught by Alden.

In response to appellant's argument that the references do not teach or fairly suggest determining a notification method, Yoon suggests some notification methods by sound, flashing screen, e-mail and other communication methods (see para. [0019]), and Alden may utilize any well known communications means via network (e.g. e-mail with attachment, direct access to the particular host web-site, dedicated link, etc.,) to deliver the scanned, digital image or data of the mail pieces to the users.

- IN RESPONSE TO appellant's argument C, Claims 3-8, 10-12 and 16-17 are not Unpatentable under 35 U.S.C. section 103(a):

In response to the appellant's arguments that are repeating the similar subject matter, please see Supra examiner's responses. Further, in response to appellant's argument that the references, individually or properly combined, do not teach or suggest detecting source information from the mail piece and

determining a notification method, the examiner respectfully requests the appellant to revisit Alden reference (e.g. Fig. 9 and the description thereof) for the GUI showing the source information, which can be detected by the user), and both Yoon and Alden for the notification method (see Supra response regarding this issue).

- IN RESPONSE TO appellant's argument D, Claims 13 and 15 are not Unpatentable under 35 U.S.C. section 103(a):

In response to Appellant's argument that the references do not teach or suggest the method including detecting a meter number, the examiner appreciates the appellant's acknowledgement that the meter number can be linked to the users of the meter. The modified system of Yoon in view of Alden would provide the user of the scanned image of the mail piece, wherein the scanned image will show every information on the mail piece as scanned. It is well known in the art that many senders use the meter to frank and mail their mail pieces; and the mail pieces, processed by the meter, must bear the meter number on it. Accordingly, when the modified system of Yoon the scans any mail piece with meter number, the user can detect the meter number from the GUI screen to further access the sender information later.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the meter number can be a key into a user database that facilitates notification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not

read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- IN RESPONSE TO appellant's argument E, Claim 14 is not Unpatentable under 35 U.S.C. section 103(a):

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

- IN RESPONSE TO appellant's argument F, Claim 16 is not Unpatentable Under 35 U.S.C. section 112, second paragraph:

Appellant's amendment to Claim 16 has not been entered because a particular amendment (i.e. just for claim 16) cannot partially be entered when the rest of the entire amendments couldn't come in. Accordingly, appellant's argument that claim 16 is not unpatentable under section 112, second paragraph is moot for the above cited reason.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Richard Woo

May 28, 2004

Conferees
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